

App. Serial No. 09/892,922
Response to 12/08/2004 Non-Final Office Action

REMARKS/ARGUMENTS

Claims 1-34 were initially pending. Claims 32-34 have been amended. The claim amendments merely move features of dependent claims 33 and 34 into their respective base claim 32, and correct grammar. The office has already had several opportunities to examine the subject matter involved in these amendments. Thus, these claim amendments do not necessitate a new search on part of the Office. No claims have been canceled, or added. Accordingly, claims 1-34 remain pending.

In view of the following remarks, Applicant respectfully requests the Office to reconsider and withdraw the rejections to the pending claims.

Claim Rejections Under 35 USC §102(b)

Claims 1-34 stand rejected under 35 USC 102(b) as being anticipated by U.S. Patent Application no. 5,740,549 to Reilly et al ("Reilly"). These rejections are traversed.

It is a fundamental principal of patent law that to anticipate a claim, a single reference must teach each and every element of the claim as set forth in the claim. (MPEP §2131).

Claim 1 recites "receiving, by the server computer, a request from the client computer for one or more requested content items", and "responsive to receiving the request: identifying, by the server computer, a data structure that refers to one or more further content items; modifying, by the server computer, the data structure to reference the requested content items; and providing, by the server computer, the content items referenced by the modified data structure to the

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client computer.” Reilly does not describe these features for the following reasons.

The Action in section 6 asserts that Reilly at col. 7, lines 50-58 describes the claimed feature of “identifying, by the server computer, a data structure that refers to one or more further content items”. This assertion is unsupportable. Let’s take a look at the portion cited by the Action as describing this claimed feature, and more particularly at the description of col. 7, lines 45-65, of Reilly.

The profiler 206 is actually a set of procedures that define and update the subscriber's user profile 194. Referring to FIG. 4, in the preferred embodiment, the user profile 194 includes:

a subscriber identifier 212;

a connection password 213 used in conjunction with the subscriber identifier when connecting to the information server to identify the calling computer as a registered subscriber;

subscriber hardware and software configuration information 214 that identifies for the information server hardware and software information needed to determine the type of software and image files that are compatible with the subscriber's computer;

a connection schedule 215 that specifies to the connection scheduler 181 within the administrative manager 180 how often the subscriber's computer should connect to the information server 104 to update its information database 184;

category and subcategory preferences information 216 that identifies categories and subcategories of news stories that the subscriber does not want to view”.

Clearly, nowhere does this cited portion describe “identifying, by the server computer, a data structure” as claim 1 recites. Instead, when interpreted within the entire context of Reilly, it is clear that a server computer (i.e., information server

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104 of Fig. 1) does not access the user profile 194 data structure of Reilly. A likely reason for this is because Reilly explicitly describes that this user profile data structure is not located on a server computer, but instead it is located on a subscriber (client 102 of Fig. 1) computer. Reilly plainly shows this in Fig. 2, wherein user profile 194 and profiler 206 are shown on the subscriber, not a server computer. (Reilly describes at col. 3, lines 33-35 that "FIG. 2 is a block diagram of a subscriber's computer in the information).

For this reason alone, Reilly does not describe each and every element of claim 1 as set forth in claim 1.

Additionally, the recited feature indicates that "responsive to receiving the request: [...] identifying, by the server computer, a data structure that refers to one or more further content items". The claimed "one or more further content items" are further content in view of "receiving, by the server computer, a request from the client computer for one or more requested content items". For the reasons already discussed above, the user profile of Reilly does not describe such "one or more further content items", as claim 1 recites.

For this additional reason, Reilly does not describe each and every element of claim 1 as set forth in claim 1.

Moreover, in view of the above explicit description of Reilly, Reilly does not describe "responsive to receiving the request: [...] modifying, by the server computer, the data structure to reference the requested content items; and providing, by the server computer, the content items referenced by the modified data structure to the client computer." This is the case even in view of the additional portions of Reilly cited by the Action as describing these claimed features. For instance, the Action asserts that Reilly at col. 8, lines 19-29,

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describes "modifying, by the server computer, the data structure to reference the requested content items". Applicant disagrees.

Let's take a look at the portion cited by the Action as describing this claimed feature, and more particularly at the description of col. 8, lines 19-29:

"The default connection schedule is for the subscriber's computer to initiate a connection to the information server once during the middle of the night (e.g., a randomly selected time between 11 p.m. and 7 a.m. local time) for an "administrative update," and once every four hours during the rest of the day for "news story updates." During the administrative update connection, the set of advertisements, scripts and images in the subscriber computer's local information database are updated as necessary, and any software upgrades are also downloaded onto the subscriber's computer".

"The default connection schedule" cited above is part of the "user profile 194" of Reilly. As described above, Reilly explicitly describes at col. 7, lines 45-46, that "[t]he profiler 206 is actually a set of procedures that define and update the subscriber's user profile 194." Reilly shows in Fig. 2 that the profiler 206 executes on the client computer 102. Thus, the system of Reilly may never "modifying, by the server computer, the data structure to reference the requested content items", as claim 1 recites.

For this additional reason, Reilly does not describe each and every element of claim 1 as set forth in claim 1.

In another example, claim 1 recites "providing, by the server computer, the content items referenced by the modified data structure to the client computer." the Action asserts that Reilly at col. 8, lines 5-15, describe this claimed feature. Applicant disagrees. Let's take a look at the portion cited by the Action as

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describing this claimed feature, and more particularly at the description of col. 8, lines 5-18

"timestamps 217a-217c indicating the time of the last updates to the subscriber computer's locally stored set of news stories, advertisements and administrative files (including scripts, images and software modules);

advertising and news item display statistics 218;

screen saver information 219 indicating the last displayed information category and the last displayed advertisement and news items in each information category are stored in a portion of the user profile 194 not transmitted to the information server; and

a screen saver exit mode indicator 220, indicating what actions cause the screen saver procedure to terminate and what actions cause the data viewer 208 to be executed."

Fig. 4 of Reilly clearly shows that the described "timestamps", "advertising and news item display statistics", "screen saver information", and "screen saver exit mode indicator 220" are part of the "user profile 194", not part of a "playlist". As shown in Fig. 2, the "user profile 194" is located on client 102. Thus, the "user profile 194" is not "the modified data structure" of claim 1 that is sent by the server to the client computer. For this reason alone, the system of Reilly may never "responsive to receiving the request: [...] providing, by the server computer, the content items referenced by the modified data structure to the client computer."

For this additional reason, Reilly does not describe each and every element of claim 1 as set forth in claim 1.

Accordingly, the 35 USC §102(b) rejection of claim 1 as anticipated by Reilly is improper and should be withdrawn.

Claims 2-9 depend from claim 1 and are not anticipated by Reilly solely by virtue of this dependency.

Accordingly, the 35 USC §102(b) rejections of claims 2-9 are improper and should be withdrawn.

Moreover, claims 2-9 include additional features that are not anticipated by Reilly. For example, claim 2 recites "wherein identifying the data structure, the data structure comprises a playlist", "wherein receiving the request, the one or more requested content items comprises streaming media content", and "wherein providing the content items further comprises streaming the content items referred to by the playlist." In addressing claim 2, the Action on page 5 asserts that Reilly describes such a "playlist" in col. 7, lines 7-12. Applicant disagrees.

Let's take a look at the portion cited by the Action as describing this feature of Fig. 2. Reilly at col. 7, lines 5-14

"timestamps 217a-217c indicating the time of the last updates to the subscriber computer's locally stored set of news stories, advertisements and administrative files (including scripts, images and software modules);

advertising and news item display statistics 218;

screen saver information 219 indicating the last displayed information category and the last displayed advertisement and news items in each information category are stored in a portion of the user profile 194 not transmitted to the information server".

Fig. 4 of Reilly clearly shows that the described "timestamps", "advertising and news item display statistics", "screen saver information", and "screen saver exit mode indicator 220" are part of the "user profile 194". As shown in Fig. 2, the "user profile 194" is located on client 102. For the reasons already discussed, the

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“user profile 194” is not a data structure identified by the server. Additionally, nowhere does this recited portion describe a “playlist”. Rather, this cited portion describe “the user profile 194”, which includes “news stories”, “advertisements”, “administrative files”, “advertising and news item display statistics”, and “screen saver information”. This information is completely silent with respect to “a playlist” as claim 2 recites. Thus, the “user profile 194” of Reilly may never be a “playlist”.

For this additional reason, Reilly does not describe each and every element of claim 1 as set forth in claim 2.

Claim 2 also recites “wherein receiving the request, the one or more requested content items comprises streaming media content”. In addressing this feature, the Action asserts that “Reilly’s ‘news feed from information transmission ... AP news feed...’ is equivalent to applicant use of the phrase ‘streaming media’”. Applicant disagrees.

Nowhere does Reilly describe client 102 sending a request for “streaming media content”. Reilly, however, does describe that a client may request full text, a photograph, a connection request, an administrative update, or a still image from an information server. For instance, Reilly at col. 4, lines 57-60 does describe that a subscriber client may request full text, which may include “photographs”. More particularly, “there are number of ways in which a subscriber can request the display of the ‘full text’ of a news item (which may include photographs and the like).” Full text, which may include a photograph, is not “streaming media content”, as claim 1 recites. Reilly also describes at col. 14, lines 30-32, that an information server 104 may receive a “connection request” from a client computer. A connection request is not a request for “streaming media content”, as

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claim 1 recites. Reilly also describes at col. 14, lines 57-61, that an information server 104 may receive "a portion of its user profile", or a request for an "administrative update". Clearly, these messages are not requesting "streaming media content", as claim 1 recites. TABLE 2 of Reilly at col. 16, lines 5-3, describe "[c]lient sends requests to Server for advertisements and scripts", and static images determined to be missing from local pools", and a "message indicate it is ready for software". Nowhere does Reilly describe that a request for an advertisement, script, a static image, or a software update is a request for "streaming media content". For each of these reasons, Reilly does not describe receiving, by the server computer, a request from the client computer for one or more requested content items", "wherein receiving the request, the one or more requested content items comprises streaming media content", as claim 2 recites.

For this additional reason, Reilly does not describe each and every element of claim 1 as set forth in claim 2.

Moreover, since Reilly does not even use the phrase "streaming media content", the Action is seemingly relying on personal knowledge of the Examiner when asserting that "Reilly's 'news feed from information transmission ... AP news feed...' is equivalent to applicant use of the phrase 'streaming media'". "When a rejection in an application is based on facts within the personal knowledge of an employee of the office, the data shall be as specific as possible, and the reference must be supported, when called for by the applicant, by the affidavit of such employee, and such affidavit shall be subject to contradiction or explanation by the affidavits of the applicant and other persons." 37 CFR §1.104(d)(2).

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In view of the above, and if this assertion that "Reilly's 'news feed from information transmission ... AP news feed...' is equivalent to applicant use of the phrase 'streaming media'" is maintained on a similar basis in a subsequent action, the Examiner is respectfully requested to supply such an affidavit to support this modification to Reilly. Otherwise, and without additional support, it is respectfully submitted the Action's conclusion that "a news feed" is equivalent to "streaming media content" does not represent the conclusion of a person of ordinary skill at the time of invention.

For each of the above reasons, the 35 USC §102(b) rejection of claim 2 is improper and should be withdrawn.

In another example, claim 3 recites "wherein identifying the data structure, the data structure comprises a first Web page specification, and the requested content comprises a second Web page specification". In addressing this claim, the Action asserts that these "first" and "second Web page specification[s]" are described by Reilly at col. 6, lines 1-9. Applicant disagrees. This portion of Reilly merely describes:

"display statistics for each advertisement are divided into a display count for displaying during data viewer usage, a display count for other display instances, and an indication of each advertisement the user has interacted with, such as by "clicking" on the advertisement to connect to the advertiser's World Wide Web page. News item display statistics 149 concern how much time the subscriber spent viewing each non-advertising item in the data viewer as well as the amount of time the screen saver".

It is respectfully submitted that "by 'clicking' on the advertisement to connect to the advertiser's World Wide Web page is completely silent on "the data structure comprises a first Web page specification, and the requested content comprises a

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second Web page specification”, as Applicant claims. Thus, and since Reilly does not describe each and every element of claim 3, Reilly cannot anticipate claim 3.

For this additional reason, the 35 USC §102(b) rejection of claim 3 is improper and should be withdrawn.

In another example, claim 4 recites “wherein modifying the data structure further comprises adding a plurality of references to the requested content item in the data structure.” In addressing this claim, the Action asserts that these features are described by Reilly at col. 4, line 39. Applicant disagrees. This portion of Reilly merely describes “[i]n the preferred embodiment, the information editor 130 is used to assign each news story to an information category and, where appropriate, to also assign the news story to one or more sub-categories.” Clearly, this cited portion of Reilly is completely silent on the features of claim 4, especially since “adding a plurality of references to the requested content item in the data structure” is performed “responsive to receiving the request”. Moreover, the data structure being relied by the Action on to describe these features is a user profile 194 data structure stored on a client computer, not on a server.

For these additional reasons, the 35 USC §102(b) rejection of claim 4 is improper and should be withdrawn.

In another example, claim 5 recites “wherein modifying the data structure further comprises adding a plural number of references to the requested content item in the data structure, the number being indicated by the request.” In addressing this claim, the Action asserts that these features are described by Reilly at col. 4, line 39. Applicant disagrees. As already discussed, this portion of Reilly merely describes “[i]n the preferred embodiment, the information editor 130 is used to assign each news story to an information category and, where appropriate,

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to also assign the news story to one or more sub-categories." Clearly, this cited portion of Reilly is completely silent on the features of claim 5, not only for the reasons provided above with respect to claim 4, but also because Reilly is completely silent on "adding a plural number of references to the requested content item in the data structure, the number being indicated by the request".

For these additional reasons, the 35 USC §102(b) rejection of claim 5 is improper and should be withdrawn.

In yet another example, claim 8 recites "wherein identifying the data structure further comprises creating the data structure by modifying a base data structure." In addressing this claim, the Action asserts that these features are described by Reilly at col. 6, lines 46-56. Applicant disagrees. Lets take a look at the cited portion:

"The workstation's secondary memory is used to store a local information database 184 that includes news stories 183, advertisements 188, images 190 and display scripts 192. In each case the workstation's secondary memory stores at least a subset of the corresponding items stored in the information server 104. The amount of information stored in the workstation's secondary memory depends on the amount of secondary memory available for storing such information, as well as a user profile 194 for the subscriber that indicates which categories and subcategories of news stories are of interest to the subscriber."

This merely describes that a local information database on the client computer stores certain information and is limited in size as a function of the amount of secondary memory. Nowhere does this teaching describe operations of a "server" that "wherein identifying the data structure further comprises creating the data structure by modifying a base data structure", as claim 8 recites.

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For this additional reason, the 35 USC §102(b) rejection of claim 8 is improper and should be withdrawn.

As an additional matter, if claim 8 is again rejected on this same basis, it is respectfully requested for the Action to particularly point out where the local information database is being created by modifying a base structure.

In yet another example, claim 9 recites “wherein identifying the data structure further comprises creating the data structure by copying a base data structure.” In addressing this claim, the Action asserts that these features are described by Reilly at col. 10, lines 10-18. Applicant disagrees. Let’s take a look at the cited portion:

“The display scripts also mix fixed images with the headline images to create varied and interesting displays. In one example of a display script, cartoon characters appear to move the headlines around. In another example of display script, the background behind and surrounding the headlines is a sequence of fixed images such as pictures of peaceful landscapes, while the headlines gently float around the portions of the display not occupied by the advertisement image 232.”

In this portion, Reilly merely describes a display script is used to display cartoon characters moving a headline in a gently floating manner. Clearly, this teaching of gently floating headlines does not describe operations of a “server” that “wherein identifying the data structure further comprises creating the data structure by copying a base data structure”, as claim 9 recites.

For this additional reason, the 35 USC §102(b) rejection of claim 9 is improper and should be withdrawn.

As an additional matter, if claim 9 is again rejected on this same basis, it is respectfully requested for the Action to particularly point out how a description of

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cartoon characters gently moving headlines around a display describe the features claimed by Applicant in claim 9.

Claim 10 recites "receiving, by a server computer, a request that refers to one or more streaming media content items", "identifying, by a server computer, a playlist that refers to a sequence of one or more further streaming media content items" modifying, by a server computer, the playlist to reference the one or more requested streaming media content items in the sequence", and "streaming, by a server computer, the streaming media content items referenced by the modified playlist to at least one requesting client computer." Reasons why Reilly does not anticipate these claimed features were already discussed above with respect to claim 1.

Accordingly, the 35 USC §102(b) rejection of claim 10 as anticipated by Reilly is improper and should be withdrawn.

Claims 11-16 depend from claim 10 and are not anticipated by Reilly solely by virtue of this dependency.

Accordingly, the 35 USC §102(b) rejections of claims 11-16 are improper and should be withdrawn.

Moreover, for the reasons already provided with respect to claims 2-9, claims 11-16 include additional features that are not anticipated by Reilly. For these additional reasons, the rejections of claims 11-16 should be withdrawn.

Claim 17 recites "receiving, by a server computer, a request from a client computer for one or more requested Web documents" and "responsive to receiving the request: identifying, by a server computer, a wrapper Web document that refers to one or more further Web documents; modifying, by a server computer, the wrapper Web document to reference the one or more requested Web

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documents; and providing, by a server computer, the Web documents referenced by the modified wrapper Web document to the client.” Reasons why Reilly does not anticipate these claimed features were already discussed above with respect to claim 1.

Moreover, Reilly is completely silent with respect to any “wrapper Web document”. The only support in Reilly for a Web page provided by the Action describes “clicking” on the advertisement to connect to the advertiser's World Wide Web page”. Clearly, this does not describe “identifying, by a server computer, a wrapper Web document that refers to one or more further Web documents”, as Applicant claims.

At least for those reasons, the 35 USC §102(b) rejection of claim 17 as anticipated by Reilly is improper and should be withdrawn.

Claims 18-23 depend from claim 17 and are not anticipated by Reilly solely by virtue of this dependency.

Accordingly, the 35 USC §102(b) rejections of claims 18-23 are improper and should be withdrawn.

Moreover, for the reasons already provided with respect to claims 2-9, claims 18-23 include additional features that are not anticipated by Reilly. For these additional reasons, the rejections of claims 18-23 should be withdrawn.

Claim 24 recites “receiving a plurality of requests from a client for one or more requested content items”, “responsive to receiving the request, and for at least a subset of the received requests: (a) identifying, by the server, a data structure containing a sequence of references to one or more further content items; (b) modifying, by the server, the data structure reference to the requested content items; and (c) communicating, by the server, the content items referenced by the

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modified data structure to the client.” Reasons why Reilly does not anticipate these claimed features were already discussed above with respect to claim 1. At least for those reasons, the 35 USC §102(b) rejection of claim 24 as anticipated by Reilly is improper and should be withdrawn.

Claims 25-31 depend from claim 24 and are not anticipated by Reilly solely by virtue of this dependency.

Accordingly, the 35 USC §102(b) rejections of claims 25-31 are improper and should be withdrawn.

Moreover, for the reasons already provided with respect to claims 2-9, claims 25-31 include additional features that are not anticipated by Reilly. For these additional reasons, the rejections of claims 25-31 should be withdrawn.

Claim 32 recites “one or more first data fields, each data field containing data therein representing a respective reference to a set of content items”, “at least one second data field containing data therein representing a respective placeholder to identify a particular point in a sequence of the one or more first data fields where a reference to a set of client requested content is to be inserted”, and wherein the data structure is a playlist or a Web page”. Nowhere does Reilly describe each of these claimed features. For instance, in addressing claim 32, the Action asserts that Fig. 8 of Reilly describes “at least one second data field containing data therein representing a respective placeholder to identify a particular point in a sequence of the one or more first data fields where a reference to a set of client requested content is to be inserted”, as claimed. Applicant disagrees.

Reilly at col. 2, lines 51-54, col. 12, lines 15-22, and col. 11, lines 64-66, respectively describe:

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"FIG. 8 and 9 schematically depict data structures stored in a subscriber's computer to indicate advertisements and news stories available for display in various information categories."

As shown in FIGS. 8 and 9, the advertisements assigned to each information category are organized, through the use of a set of data access tables 186, in a separate linked list so as to create a separate "queue" of advertisements for each information category. Similarly the news items and display scripts assigned to each information category are organized in separate linked lists so as to generate separate queues of news items and display scripts for each information category."

And,

"[r]eferring to FIG. 8, news stories, advertisements and display scripts are stored in files or similar data structures which have assigned unique file names."

Clearly, the data structure Reilly describes in reference to Fig. 8 uses tables and linked lists to identify files that contain material for presentation on a subscriber's computer. This cited description does not explicitly or inherently describe that the data structure of Fig. 8 includes any "placeholder" identifying where "a set of client requested content is to be inserted," especially wherein "the data structure is a playlist or a Web page", as claim 32 recites.

With respect to the claimed "playlist", the Action asserts on page 7, in reference to the rejection of claim 33, that Fig. 5 of Reilly shows the claimed "playlist". This conclusion is unsupportable. Reilly explicitly describes at col. 3, lines 43-44, that "FIG. 5 schematically depicts the dialog box used to define the user profile for one information category." A dialog box is not a "playlist". Thus, a system of Reilly may never include a "wherein the data structure is a playlist".

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Additionally, and with respect to “wherein the data structure is a [...] web page”, the Action asserts on page 7, in reference to the rejection of claim 34, that Reilly at col. 13, lines 9-14 describe the claimed “wherein the data structure is a [...] web page”. This conclusion is also unsupportable. Reilly explicitly describes at col. 13, lines 9-14, that:

“When using the second screen saver exit mode, if subscriber user clicks on an advertisement, the subscriber's computer is automatically connected to the an associated World Wide Web page on the Internet that provides additional information from the advertiser. This is accomplished by World Wide Web connection and viewer procedures 211”.

Clearly, Reilly at col. 13, lines 9-14 merely describes that a user can browse to a Web page by clicking on a advertisement. A description of browsing Web pages does not describe “one or more first data fields, each data field containing data therein representing a respective reference to a set of content items”, “at least one second data field containing data therein representing a respective placeholder to identify a particular point in a sequence of the one or more first data fields where a reference to a set of client requested content is to be inserted”, and wherein the data structure is a playlist or a Web page”, as claim 32 recites.

For each of the above reasons, Reilly does not describe each and every element of claim 32. Thus, Reilly does not anticipate claim 32.

Accordingly, the 35 USC §102(b) rejection of claim 32 is improper and should be withdrawn.

Claims 33 and 34 depend from claim 32 and are not anticipated by Reilly at least by reason of this dependency. Accordingly, the 35 USC §102(b) rejection of claims 33 and 34 should be withdrawn.

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Additionally, these claims include additional subject matter that is not described by Reilly. For example, claim 34 recites "wherein the content items are a first set of Web page specifications", and "wherein the client requested content are one or more second Web page specifications". For the reasons already discussed above with respect to claim 3, Reilly does not anticipate these claimed features.

For this additional reason, the 35 USC §102(b) rejection of claim 34 should be withdrawn.

Conclusion

Claims 1-34 are in condition for allowance and action to that end is respectfully requested. Should any issue remain that prevents allowance of the application, the Office is encouraged to contact the undersigned.

Respectfully Submitted,

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